



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/809,144

03/25/2004

Robert Costa

03-284-E

7397

20306

7590

12/13/2006

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER

HALVORSON, MARK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/809,144	Applicant(s) COSTA ET AL.	
	Examiner Mark Halvorson	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-49 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 12-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10, 12-49 are pending.

Claim 4-7 and 12-49 have been withdrawn.

Claims 1-3 and 8-10 are under currently under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 35 USC § 112 2nd paragraph rejection withdrawn

The rejection of claims 1-3, and 8-10 for being indefinite is withdrawn in view of the amendment of claim 1.

35 USC § 102(b) rejections maintained

The rejection of claims 1-3, and 8, under 35 U.S.C. 102(b) as being anticipated by Sherr et al is maintained.

Applicant argues that Sherr et al do not teach a method of inhibiting tumor cell proliferation by contacting cells with a p19ARF protein fragment having the sequence of SEQ ID NO:10. However, as amended, claim 1 is drawn to a p19ARF protein fragment that has the amino acid sequence of SEQ ID NO:10. The transitional phrase "has" after the phrase "p19ARF protein fragment" is considered as open as to the scope of the claimed protein. The phrase "p19ARF protein fragment that has the amino acid sequence as set forth in SEQ ID NO:10" is interpreted to include the full-length protein

taught by the prior art of record. Thus, claim 1, as amended, encompasses the p19ARF peptide described by Sherr et al

35 USC § 103(a) rejections maintained

The rejection of claims 1, 9-10 under 35 U.S.C. 103(a) as being unpatentable over Sherr et al in view of Laes et al is maintained.

Applicant again argues that Sherr et al do not teach a method of inhibiting tumor cell proliferation by contacting cells with a p19ARF protein fragment having the sequence of SEQ ID NO:10. However, as amended, claim 1 is drawn to a p19ARF protein fragment that has the amino acid sequence of SEQ ID NO:10. The transitional phrase "has" after the phrase "p19ARF protein fragment" is considered as open as to the scope of the claimed protein. The phrase "p19ARF protein fragment that has the amino acid sequence as set forth in SEQ ID NO:10" is interpreted to include the full-length protein taught by the prior art of record. Thus, claim 1, as amended, encompasses the p19ARF peptide described by Sherr et al.

Summary

Claims 1-3 and 8-10 stand rejected.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

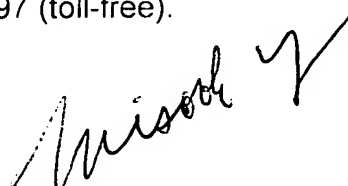
Art Unit: 1642

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halvorson, PhD whose telephone number is (571) 272-6539. The examiner can normally be reached on Monday through Friday from 8:30am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787. The fax phone number for this Art Unit is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Halvorson, PhD
Patent Examiner
571-272-6539


MISOOK YU
PRIMARY EXAMINER